

Application No.: 10/044237

Case No.: 55476US003

The Examiner stated that the inventions I and II are distinct, each from the other because Inventions I and II are unrelated. In the instant case, the Examiner averred that the different inventions are not disclosed as capable of use together, have different modes of operation (invention I required pick-and-place devices (rolls) having the same or substantially the same period, while invention II requires only that the rolls be "periodic"). Further, according to the Examiner, claim 26 recites that defect minimization may be achieved by changing the period or size of caliper variation, while invention I requires that roll contact effect defect minimization.

According to the Examiner, inventions I and III are related as process and apparatus for its practice. In this case, the Examiner asserted that the apparatus of invention III can be used to practice a process in which contact is made in a non-periodic fashion, thereby yielding an uneven, non-uniform coating.

The Examiner averred that inventions II and III are related as process and apparatus for its practice. The Examiner stated in this case that the apparatus of invention III can be used to practice a process in which contact is made in a non-periodic fashion, thereby yielding an uneven, non-uniform coating. Additionally, the Examiner stated that claim 26 can be practiced with an apparatus equipped only with means for caliper variation, rather than period of roll contact to achieve defect minimization.

The Examiner averred that the restriction for examination purposes is proper because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification.

Applicants' Response to the Restriction under 35 U.S.C. 121

Applicants elect, with traverse, to prosecute the invention of group I comprising the method for improving the uniformity of a wet coating on a substrate and a method for coating a moving web as recited in Claims 1-25 and 29-31. Applicants submit that the recited claims of group I in the Office Action improperly indicated "claims 1-2" and should have read "1-25."

Applicants respectfully traverse the restriction requirement. M.P.E.P. § 803 requires that the two conditions be met for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed. Second, there must also be serious burden on the Examiner if restriction is not required (see M.P.E.P. §803.02; §806.04 (a)-(j); §808.01 (a); and §808.02).

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Applicants submit the restriction between groups I, II and III is improper because the claims would not impose a serious burden on the Examiner if the groups were prosecuted under the same application. In support, applicants respectfully point out that the claims of all groups represent improvements in coating uniformity. Additionally, groups I and II are in the same class and subclass. Reconsideration of the restriction requirement and continued prosecution of this application is respectfully requested.

It is believed that no fee is due; however, in the event a fee is required, please charge the fee to Deposit Account No. 13-3723. The Examiner is invited to contact the undersigned at the indicated telephone number with questions that can be resolved with a simple teleconference.

Respectfully submitted,

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Date

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